

### **REMARKS**

This is a full and timely response to the outstanding final Office Action mailed October 20, 2006. Through this response, Applicants have canceled claims 13-19 and 28-35 without prejudice, waiver, or disclaimer. Reconsideration and allowance of the application and pending claims 20-27 are respectfully requested.

#### **I. Claim Rejections - 35 U.S.C. § 103(a)**

##### **A. Rejection of Claims 20, 21, 23-26, 28-30, and 32-35.**

Claims 20, 21, 23-26, 28-30, and 32-35 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Matthews, III* ("Matthews," U.S. Pat. No. 5,874,985) in view of *Hendricks, et al.* ("Hendricks," U.S. Pat. No. 5,600,573). Claim 31 has been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Matthews* and *Hendricks* in view of *Tanaka, et al.* ("Tanaka," U.S. Pat. No. 2003/0115600 A1). Claims 13-19 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Matthews* in view of *Hendricks* and *Tanaka*. Claims 22 and 27 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Matthews* and *Hendricks*, and further in view of *Jennings* (U.S. Pat. No. 5,781,186). Applicants have canceled claims 13-19 and 28-35, thus rendering the rejection to those claims moot. Applicants respectfully traverse the rejections pertaining to pending claims 20-27.

##### **B. Discussion of the Rejection**

The U.S. Patent and Trademark Office ("USPTO") has the burden under section 103 to establish a *prima facie* case of obviousness according to the factual inquiries expressed in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). The four factual inquiries, also expressed in MPEP 2100-116, are as follows:

- (A) Determining the scope and contents of the prior art;
- (B) Ascertaining the differences between the prior art and the claims in issue;
- (C) Resolving the level of ordinary skill in the pertinent art; and
- (D) Evaluating evidence of secondary considerations.

Applicants respectfully submit that a *prima facie* case of obviousness is not established using the art of record.

#### **Independent Claim 20**

Claim 20 recites (with emphasis added):

20. A system for providing customizable multimedia messages over a television system to a communications terminal for presentation to a user, comprising:

at least one application server that generates at least one message configuration, each application server being capable of providing interactive services that enable a communications terminal to communicate over the television system;

a multimedia messaging server that receives at least one message configuration from the at least one application server and associates message content for presentation to a user according to the at least one message configuration, and generates a request according to the at least one message configuration, the request including the message content and a message configuration expression for delivery over a television system to the communications terminal associated with the user, **wherein the at least one application server and the multimedia messaging server are located in the headend**, the multimedia messaging server being capable of managing the delivery of the request over the television system to the communications terminal, thereby conserving system bandwidth; and

a multimedia messaging client that receives the request and associates the message content and the message configuration for presentation of the message content according to the message configuration.

Applicants respectfully submit that *Matthews* in view of *Hendricks* fails to disclose, teach, or suggest at least the above emphasized claim features. As admitted in the Office Action (page 4), *Matthews* fails to disclose “wherein the at least one application server and the multimedia messaging server are located in the headend.” Applicants respectfully submit that *Hendricks* fails to remedy this deficiency. The Office Action (page 20) alleges that the

operations center 202 in Figure 2 of *Hendricks* is a headend, as allegedly supported by the IEEE dictionary definition for a “headend.” In particular, the Office Action alleges (on page 20) the following:

The operations center of Hendricks, as seen in Fig. 1, clearly qualifies as a “headend”, as it is the central location receiving programming for transmission downstream to the plurality of cable headends and receiving upstream communications from the plurality of cable headends. The mere fact that Hendricks has given the operations center a different label does not change the fact that it clearly meets the definition of a headend.

Applicants disagree. The definition provided in the IEEE dictionary states that a headend is the “central location that has access to signals traveling in both inbound and outbound directions. The logical root of the broadband coaxial cable system.” The definition further provides that the headend is the “physical location where the inbound and outbound paths are accessible. The headend is also called the central retransmission facility.” If reliance is placed on the fact that the headend is the “central location” that has “access to signals traveling in both inbound and outbound directions,” Applicants respectfully note that from Figure 1, the headend 208 or the set-top terminal 220 could constitute a central location that has access to inbound and outbound paths. Is the suggestion being made that the set-top terminal could also be considered a headend? Further, where is the logical root? Applicants respectfully submit that the logical root in *Hendricks* is at the headend 208, not the operations center 202. According to MPEP 2111, the “broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999).” Applicants respectfully note that one skilled in the art would not interpret the operations center as a headend given that *Hendricks* clearly distinguishes the two entities, and in fact, describes the benefits of having the two separate and distinct entities for video on demand applications (see, e.g., column 20, lines 1-19). In other words, one having ordinary skill in the art would recognize that a headend and an

operations center are distinct entities. Clearly *Hendricks* thought that there was a distinction, as headend and operations centers were treated as distinct and separate entities. Thus, Applicants respectfully submit that the interpretation set forth by the Office Action is inconsistent with what one having ordinary skill in the art would reach.

Additionally, Applicants respectfully note that the headend described in Applicants' disclosure does not provide delivery to another headend, unlike the operations center in *Hendricks*, and thus the interpretation of the operations center of *Hendricks* as a headend is also inconsistent with the headend described in Applicants' disclosure. Thus, Applicants respectfully submit that a prima facie case of obviousness has not been established, and accordingly, the rejection should be withdrawn.

Because independent claim 20 is allowable over *Matthews* in view of *Hendricks*, dependent claims 21 and 23-24 are allowable as a matter of law for at least the reason that the dependent claims 21 and 23-24 contain all elements of their respective base claim. See, e.g., *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Further, with regard to the rejection to claims 22, since independent claim 20 is allowable over *Matthews* in view of *Hendricks*, and that the deficiencies of *Matthews* in view of *Hendricks* are not remedied by *Jennings*, Applicants respectfully submit that dependent claim 22 is allowable for at least the reasons that dependent claim 22 incorporates the features of allowable claim 20.

### **Independent Claim 25**

Claim 25 recites (with emphasis added):

25. A system for delivery of multimedia messages, comprising:  
a multimedia messaging server; and  
at least one application server in which each server generates message content and a database of predefined message configurations, each application server being capable of providing interactive services that

enable a communications terminal to communicate over the television system,

wherein each application server delivers the message content and at least one of the database of predefined message configurations to the multimedia messaging server, which in response thereto, generates a request that comprises the message content and a message configuration expression for delivery over a television system to a communications terminal associated with the user, ***wherein the at least one application server and the multimedia messaging server are located in the headend***, the multimedia messaging server being capable of managing the delivery of the request over the television system to the communications terminal, thereby conserving system bandwidth.

For similar reasons presented above in association with claim 20, Applicants respectfully submit that *Matthews* in view of *Hendricks* fails to disclose, teach, or suggest at least the above emphasized claim features. Accordingly, Applicants respectfully request that the rejection to independent claim 25 be withdrawn.

Because independent claim 25 is allowable over *Matthews* in view of *Hendricks*, dependent claim 26 is allowable as a matter of law.

Further, with regard to the rejection to claims 27, since independent claim 20 is allowable over *Matthews* in view of *Hendricks*, and that the deficiencies of *Matthews* in view of *Hendricks* are not remedied by *Jennings*, Applicants respectfully submit that dependent claim 27 is allowable for at least the reasons that dependent claim 27 incorporates the features of allowable claim 20.

In summary, it is Applicants' position that a *prima facie* for obviousness has not been made against Applicants' claims. Therefore, it is respectfully submitted that each of these claims is patentable over the art of record and that the rejection of these claims should be withdrawn.

## **II. Official Notice**

The Office Action takes Official Notice with regard to claim 19. As Applicants have canceled claim 19, Applicants believe the rejection to be rendered moot. However,

Applicants note for the record that Applicants disagree with the taking of Official Notice given the context and complexity of the claimed features (of claims 13 and 19) and for the reason that, in view of that complexity, the conclusions did not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions. Further, Applicants respectfully disagree with the Office Action allegation that the prior traversals were inadequate. As set forth in the prior Response, and herein incorporated by reference, Applicants respectfully submit that all traversals were set forth as required by MPEP 2144.03. Hence, applicants respectfully repeat their request that the conclusion of admitted prior art be withdrawn from the record, and further request that the next Office Action provide documentary evidence to support all Official Notices herein and previously traversed, or alternatively, withdraw the rejections.

### **III. Canceled Claims**

As identified above, claims 13-19 and 28-35 have been canceled from the application through this Response without prejudice, waiver, or disclaimer. Applicants reserve the right to present these canceled claims, or variants thereof, in continuing applications to be filed subsequently.

### **CONCLUSION**

Applicants respectfully submit that Applicants' pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official

notice, and similarly interpreted statements, should not be considered well known since the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

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